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Varian Inc.
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EXAMINER

MENON, KRISHNAN S

ART UNIT PAPER NUMBER

1723

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,110

Applicant(s)

HERINGA ET AL.

Examiner

Krishnan S Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-20 are pending.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Netherlands on 10/13/00. It is noted, however, that applicant has not filed a certified copy of the Foreign application as required by 35 U.S.C. 119(b).

Election/Restrictions

Newly submitted claims 19 and 20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions in claims 19-20 and claims 1-18 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19 and 20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to the examiner as to what is claimed in claim 1: the combination of the carrier and the support structure comprising a wound chromatographic column, or the sub-combination of the carrier with a connecting part connecting the carrier to the support structure. The examiner considers claim 1 as reciting the sub-combination for examination purposes. In claim 1, it is also unclear as to what component is connected to the support structure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5,6, 8,10-14 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rounbehler et al (US 5,808,178).

Rounbehler (178) teaches a carrier (120-fig 2-3) for the support structure having a chromatographic column assembly (110-fig 1; col 3 lines 30-35) as in instant claim 1 with a connecting part (140, 125) to the support structure (118); the carrier is in the form of a strip (120-fig 3) as in instant claim 2 with apertures as in instant claim 3 (unmarked hole on top of 120-fig 3); the carrier comprises metal as in instant claim 5 (col 3 lines 43-49); a part for mounting a column connector (200-fig 6-8; col 4 lines 14-21) as in instant claim 6; the carrier has a device for holding the column (holder 118 – fig 3) as in instant claim 8; the carrier has a structure for winding the column

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(120- fig 2,3) as in instant claim 10 which includes one or more connectors for connecting to the carrier (125,145-fig 2-3) as in instant claim 11. The rings (125-fig 2,3) have hooks (140 fig 2-3) to connect to the holder (118-fig 2,3) as in instant claim 12. The structure comprises upper and lower annular members (125) connected by plurality of connecting bars (120) and forms the connectors as in claim 13 (Note: claim 13 is depending from claim 10; however, claim 10 does not recite 'connectors', which appears to be an error).

Rounbehler (178) teaches a strip form (120) with slots 135 (fig 3) forming "clips" to hold ends of the chromatographic column as in instant claim 14.

Claim 1/: Rounbehler teaches a chromatographic column comprising a column assembly comprising a winding structure (110), a tubular gas chromatographic column wound on the winding structure (118), a strip shaped carrier attaches to the structure at two opposite ends of the carrier (120), the strip allows a user to carry the column (see fig 2,3; and col 3 lines 30-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 7,9,15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rounbehler (178) in view of Haas et al (US 6,454,939).

Rounbehler (178) teaches a strip form part for use with a winding structure of a chromatographic column as in instant claim 15 and 16, and all the elements of claims 7 and 9 as in claim 1 above, but is silent on displaying information as in instant claim 7 and 15 and the strip part containing indicia as in instant claim 9 and 16.

Haas (939) teaches such a strip with display information and measurement indicia and/or stencil for marking/measuring the TLC plates, for a thin-layer chromatographic system (see fig 2 and col 2 lines 40-45). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Haas (939) and provide display information and measurement indicia on the strip form parts of Rounbehler (178) for measuring insertion depth or column length like what is taught by Haas (939).

2. Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rounbehler (178).

Rounbehler teaches all the limitations of claim 1 and 17. Claims 4 and 18 add further limitations of a further support structure with further wound chromatographic column as in claim 4 and 18, with the winding concentric as in claim 18. Rounbehler does not teach further support structure in Fig 2 and 3 and col 3 lines 30-35. However Rounbehler teaches a further chromatographic column (more than one column) in a concentric arrangement in fig 25 and col 22 lines 3-15. It would be obvious to one of ordinary skill in the art at the time of invention to have a

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further (second) column wound on to the structure 118 as taught by Rounbehler, by having a further structure (118) (an extension) for carrying additional columns or decoy columns as taught by Rounbehler.

Response to Arguments

Applicant's arguments filed on 4/18/03 have been fully considered but they are not persuasive. Argument re claim 1: Claims 1 claims a carrier allowing a user to carry a chromatographic column mounted on a support structure. Strip 120 is a carrier because it allows one to carry the column (135) and the support structure (118). 120 is connected to the support structure 118. Argument re claims 14-16: again, 120 is in a strip form, and support structure 118 could be held by 120.

Conclusion

This action is made non-final because the examiner inadvertently missed treating claim 13 on merits in the previous office action (paper 5).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Krishnan Menon
Patent Examiner
June 6, 2003

Joseph Drodge
JOSEPH DRODGE
PRIMARY EXAMINER